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WASHINGTON, DC 20005

EXAMINER

OBEID, MAMON A

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,875	Applicant(s) SHIONOYA ET AL.	
	Examiner MAMON OBEID	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-3 and 5-8.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This communication is in response to the claims amendment filed December 15, 2008.
2. Claims 1-3 and 5- 8 are pending and have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 8 is rejected under 35 U.S.C. §101 because the claims are considered hybrid claims. See MPEP §2173.05(p) II. If Applicants overcome the related 35 U.S.C. §112 2nd paragraph rejection below, this particular 35 U.S.C. §101 rejection will be withdrawn.

Claim Rejections - 35 U.S.C. §112 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 is rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 8 is indefinite because the claim is considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C §101. For example, claim 8 begins "a system for reading an information recording medium" In light of this evidence, the Examiner interprets that recitation as express intent by Applicants to claim a *product* claim. Claim 8 however continues with "wherein in said prescribed control information contains a control for said prescribed reproduction device to perform a plurality of functions, the functions comprising:" followed by a series of three (3) method steps. In light of Applicants' recitation of no less than three (3) method steps, the Examiner interprets these particular recitations of method steps as express intent by Applicants to claim a *process* claim. In light of the conflicting evidence noted above, claim 8 could reasonably be drawn to either a product or process. In accordance with §2173.05(p) II. which states that a single claim must be drawn to either a product or process (but not both) and because a competitor of Applicants would not know whether *possession* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited three (3) method steps, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claim 8 as claims directed to a product only.

Claim Rejections – 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1- 3 and 5- 8, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Colvin (U.S. Patent No. 6,799,277 B2) (“Colvin”) in view of Braitberg et al. (U.S. Patent No. 6,631,359 B1) (“Braitberg”) and further in view of Umeda et al (U.S. Patent No. 5,581,547).

10. **As per claims 1, 3 and 8:** Colvin discloses the following:

- a. presenting an acquisition code (e.g. “activation key”) prerecorded on said information recording medium (e.g. distributing media) to a viewer (e.g. user) desiring to view a viewing management target content (e.g. digital content or software) (column 9, lines 54- 66; column 5, line 53- column 6, line 7 ; column 19, lines 56- 64; figure 1a and related text);
- b. receiving a password (“authorization code” or “password”) acquired by the viewer from a server computer (e.g. “remote server”) based on the acquisition code (column 3, lines 1- 39; figure 2 and related text);
- c. starting the reproduction of said viewing management target content via an authentication process based on the password (column 7, lines 32- 65));

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- d. wherein a password management table (authorization table/ database **670**) associating said password with said acquisition code is prerecorded on said information recording medium (column 5, line 53- column 6, line 7 ; column 19, lines 56- 64; figures 3, 4a-4b, 14b and related text);
 - e. the step of presenting the acquisition code occurs each time a content reproduction request is received from the viewer (column 5, line 53- column 6, line 7).
 - f. said prescribed reproduction device generating a random number based on a prescribed random function (column 5, line 53- column 6, line 7 ;column 9, lines 54- column 10, lines 1- 18).
 - g. said prescribed reproduction device selecting and presenting an acquisition code corresponding to the generated random number from the password management table (column 5, line 53- column 6, line 7 ;column 9, lines 54- column 10, lines 1- 18; column 12, lines 12- 27).
11. Colvin does not expressly disclose recording the password table in the recording medium. However, Braitberg discloses recording license information onto a recording medium, wherein said license information is request each time a user reproduce content (e.g. license is granted only for one play or reproduction) (column 11, lines 5- 17; column 13, lines 4- 15; figure 2 and related text).

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12. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Colvin's teachings to include recording a license information such as password table on the recording medium and disclosed by Braitberg to enable the copyright holder updating, controlling or correcting the control information (license information) previously prerecord on a recording medium to increase content security and to reduce content piracy (see Braitberg at column 6, lines 8- 14; column 14, lines 39- 46).

13. Colvin further discloses password sequence lookup table **210** and **218**, each including an initial registration password and related passwords associated with subsequent authorization intervals (column 12, lines 12- 27). Colvin further discloses a unique, random identifier field **592** (figure 13a). Colvin further discloses an authorization table or database **670**. The database may include fields to identify each copy of the installation media **672** (e.g. random number) along with corresponding activation keys **674** and encryption keys **676** (figure 14b and related text). Braitberg further discloses generating an identifier using a random function (column 13, lines 60- 66).

14. The combination Colvin/ Braitberg does not expressly disclose selecting and presenting an acquisition code corresponding to the generated random number from the password management table. However, Umeda discloses randomly selecting and

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presenting one of the spreading codes (**c1-c3**) for each transmission (column 8, lines 13, 18; column 9, lines 7- 21; figure 12).

15. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the combination's (Colvin/ Braitberg) teachings to include the step of randomly selecting a spreading code (e.g. corresponding to applicants' "acquisition code") corresponding to a random number disclosed by Umeda to decrease the probability of using the same acquisition code by multiple users thereby increasing efficiency (Umeda: column 3, lines 18- 26). Another motivation is to prevent the legal consumer from distributing the "acquisition code" to illegal consumers (e.g. acquisition code is variable) and hence preventing content piracy and generating more revenues for content providers and distributors.

16. **As per claim 2:** Colvin discloses when said viewer acquires the password from said server computer, a viewing fee of said viewing management target content is charged to said viewer (column 21, lines 9- 30).

17. **As per claim 5:** Colvin discloses the following:

h. wherein said server computer comprises a viewing management database containing a table corresponding to said password management table (figures 3, 4a- 4b, 14b and related text), and

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i. wherein a prescribed password corresponding to the prescribed acquisition code received from the information terminal device of said viewer is specified by referring to said viewing management database, and the prescribed password is presented to said viewer (figures 3, 4a- 4b, 14b and related text).

18. **As per claim 6:** Colvin discloses the following:

j. wherein position information for the server is recorded on said information recording medium(column 18, lines 30- 41), and

k. said prescribed reproduction device presents said prescribed acquisition code together with said prescribed position information (figures 3, 4a- 4b, 14b and related text).

19. **As per claim 7:** Colvin discloses wherein said viewing management method further comprises a step of urging said viewer to select a viewing management target content (figure 8 and related text).

20. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the

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entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

21. Applicant's arguments filed December 15, 2008 have been fully considered but they are not persuasive.

22. Applicants argue (page 10): "In other words, at best, the Colvin patent discloses determining an activation key first and then afterwards determining a random number for that activation key. However, in the invention claimed in independent claims 1, 3, and 8, the random number is determined first and afterwards the acquisition code corresponding to the random number is determined". The Examiner however disagrees. Colvin discloses a password sequence look-up table **210** which is references by a pseudo-random serial numbers generated by random function; said reference number or table (e.g. table 0001) is correlated with an activation key and at least one password (column 5, line 53- column 6, line 7 ;column 9, lines 54- column 10, lines 1- 18; column 12, lines 12- 27).

23. In response to applicant's argument (page 10) that Umeda is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the

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claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Further Colvin discloses a password sequence look-up table **210** which is referenced by a pseudo-random serial numbers generated by random function; said reference number or table (e.g. table 0001) is correlated with an activation key and at least one password (column 5, line 53- column 6, line 7; column 9, lines 54- column 10, lines 1- 18; column 12, lines 12- 27; figure 3). Furthermore, Umeda clearly discloses selecting a spreading code (corresponding to Applicants acquisition code which is correlated with a password) using random number to prevent using the same acquisition code twice by more than one user thereby making each use of the spreading code unique for each user or for each request/ message (Umeda: column 8, lines 19- 35).

24. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAMON OBEID whose telephone number is (571)270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
AU 3621

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